

REMARKS***Interview***

Applicants thank the Examiner for withdrawing the restriction requirement with regard to complements or fragments of SEQ ID NO: 34 as discussed in the interview of 26 April 2005.

Applicants agree with the Examiner that no final agreement was reached, and respectfully submit that the interview summary correctly states that the “general result” was that the Examiners would be “amenable,” to an amendment and would permit the application to pass to allowance, from which it follows the amendment would have to be considered. The summary further states the “possibility of allowance” of claims 145, 148-150, 154, 156, 161, and 165-174 was discussed.

Election Restriction

In view of the withdrawal of the election restriction requirement with regard to complements or fragments of SEQ ID NO: 34, claims 145, 156, 166-173, and 175-193 are currently pending.

Rejections Under 35 U.S.C. § 112 ¶ 2***¶***

In view of the cancellation of claims 150, 154, 161, and 165, Applicants respectfully submit that the rejection under § 112 ¶ 2 is rendered moot, and respectfully request withdrawal of the rejection.

Rejections Under 35 U.S.C. § 102

Claims 166 - 174 are rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Nguyen. *et al.* J. Biol. Chem. 273(11) 6341-6350 (1998).

In rejecting claims 166-174 over Nguyen. *et al.* the Office Action asserts that to the extent claims are drawn to SEQ ID NO:34, the instant application is not entitled to the filing date of its parent. The basis for the assertion are the allegations that SEQ ID NO:34 is neither disclosed in the parent application, nor is there a teaching that would lead one to SEQ ID NO: 30. Applicants respectfully disagree.

An application is entitled to priority under 35 U.S.C. § 120 provided it recites a claim for priority in specification, is filed by an inventor or inventors previously named, and the

application to which a priority benefit is claimed discloses the invention as provided by 112 first paragraph. 35 U.S.C. § 120. Under 35 U.S.C. § 120 “a claim in a continuation-in-part application that is directed solely to subject matter adequately disclosed under 35 U.S.C. § 112, first paragraph, in the parent application is entitled to claim priority from the filing date of the parent application” *Applied Materials Inc. v. Advanced Semiconductor Materials America Inc.*, 98 F.3d 1563, 1575 (Fed. Cir. 1996) (Archer, C.J., concurring). 35 U.S.C. § 112 first paragraph sets forth “a best mode, enablement, and written description requirement.” *Id.* at 1579 (Meyer, J., concurring). The incorporation of the requirement of section 112 into section 120 ensures that the inventor had possession of the later-claimed invention on the filing date of the earlier application” *Kennecott Corp. v. Kocera Int. Inc.*, 835 F.2d 1419, 1421 (Fed. Cir. 1987) (citing *In re Edwards*, 568 F.2d 1349, 1351 (CCPA 1978)).

Compliance with the written description requirement is found when the disclosure sets forth “such descriptive means as words, structures, figures, diagrams formulas, etc., that fully set forth the claimed invention.” *Enzo Biochem*, 296 F.3d at 1329 (quoting from *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)). Written description of nucleic acids, which “requires a precise definition, such as by structure, formula, chemical name, or physical properties” is satisfied by providing the sequence of the claimed nucleic acids. *See, Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997), *Fiers v. Revel*, 984 F.2d 1164, 1171 (Fed. Cir. 1993)). Drawing provided in a patent application may be relied upon by an inventor to supply written description of an invention. *VasCath Inc v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991).

Applicants respectfully submit that U.S. Patent Application 08/938,669¹ fully supports the instant claims that recited SEQ ID NO:34, and that the instant application is entitled to the priority date of that application. The allegation that the ‘669 specification fails to support a claim of priority under 120 is based upon an assertion that the specification of ‘669 fails to comply with 35 U.S.C. § 112 first paragraph. More specifically, the allegation is based on an asserted failure to describe SEQ ID NO:34 (*i.e.*, meet the written description requirement), as

¹ Now U.S. Patent No.: 6,171,788.

opposed to an allegation that the specification fails to enable the use of SEQ ID NO:34 or to meet the best mode requirement of § 112.

The '669 specification provides a description of the sequence of SEQ ID NO: 34 sufficient to satisfy the requirement the written description requirement of § 112. Figure 1E calls out the start sites for transcription at nucleotides 5272 and 5273 of the sequence set forth in that figure. Because Fig. 1 clearly demarcates the boundary between boundary between the last untranscribed nucleotide (*i.e.*, 5271) and the first transcribed nucleotide, at position 5272, it depicts and supports presentation of nucleotides sequence corresponding to nucleotides 1-5271 as an independent sequence, such as in SEQ ID NO: 34. The mere fact that this feature is recited in a figure does not preclude its use as support for written description. *VasCath*, 935 F.2d at 1564. Moreover, the figures and sequence listing set forth in the '669 specification provide a "precise definition" by structure or formula by way of the sequences actual sequences presented and therefore further support the written description of SEQ ID NO.: 34.

In view of the foregoing, Applicants respectfully submit that the rejection over Nguyen *et al* should be withdrawn as the claims are entitled to the priority date of the '669 application, September 26, 1997, and thus the Nguyen *et al.* is not art under any provision of § 102(a).

Claims 145 and 156 are rejected under 35 U.S.C. § 102(b) and 102(e) as allegedly being anticipated by Weber *et al.* (U.S. 5,582,979).

In view of the amendments to the claims to recite either fragments about 250 nucleotides in length of SEQ ID NO:34 or their complements, or to recite fragments about 250 nucleotides in length of nucleotides 1 through 5271 of SEQ ID NO: 3, and fragments about 250 nucleotides in length of the complement of nucleotides 1 through 5271 of SEQ ID NO: 3, Applicants respectfully submit that the rejection is moot and respectfully request its withdrawal. Whatever else Weber *et al.* teaches it does not teach either: a nucleic acid that comprises a nucleotide sequence selected from either the group consisting of: SEQ ID NO: 34, a fragment of about 250 nucleotides in length of SEQ ID NO: 34, the complement of SEQ ID NO: 34, and the complement of a fragment of about 250 nucleotides in length of SEQ ID NO: 34; or the group consisting of a nucleic acid comprising a nucleotide sequence selected from the group consisting of: nucleotides 1 through 5271 of SEQ ID NO: 3, the complement of nucleotides 1 through 5271 of SEQ ID NO: 3, fragments about 250 nucleotides in length of nucleotides 1 through 5271 of

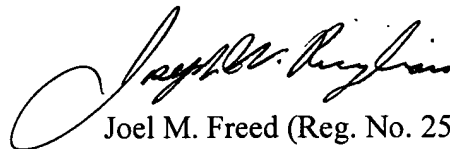
SEQ ID NO: 3, and fragments about 250 nucleotides in length of the complement of nucleotides 1 through 5271 of SEQ ID NO: 3.

In view of the foregoing, Applicants respectfully request withdrawal of the rejection over Weber *et al.*

CONCLUSION

In view of the above, each of the presently pending claims is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding objection and rejections of the claims, and to pass this application to issue. The Examiner is encouraged to contact the undersigned at (202) 942-5174 should any additional information be necessary for allowance.

Respectfully submitted,



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**Admitted to practice in Virginia and before the U.S. Patent and Trademark Office only; practicing law in the District of Columbia pending approval of application for admission to the D.C. Bar and under the supervision of attorneys who are members in good standing of the D.C. Bar.*

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